



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

HL

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/696,433	10/29/2003	Ping Zhou	AM100055-D3	6831
25291	7590	10/04/2004	EXAMINER	
WYETH PATENT LAW GROUP 5 GIRALDA FARMS MADISON, NJ 07940			SAEED, KAMAL A	
			ART UNIT	PAPER NUMBER
			1626	

DATE MAILED: 10/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/696,433	Applicant(s) ZHOU ET AL.	
	Examiner Kamal A Saeed	Art Unit 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 10-14 & 20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ~~10-14 and 20~~ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☒ Claim(s) 1-9 and 15-19 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/29/03</u> . | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1626

DETAILED ACTION

Claims 1-20 are pending in this application. Claims 1-9 (in part), 9-14, 15-19 (in part) and 20 are withdrawn from further consideration by the Examiner, 37 C.F.R. § 1.142(b), as being drawn to a non-elected invention. The withdrawn subject matter is patentably distinct from the elected subject matter as it differs in structure and element and would require separate search considerations. In addition, a reference, which anticipates one group, would not render obvious the other.

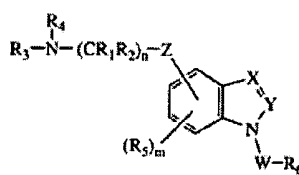
Information Disclosure Statement

Applicant's Information Disclosure Statements, filed on October 29, 2003 have been considered. Please refer to Applicant's copy of the 1449 submitted herewith.

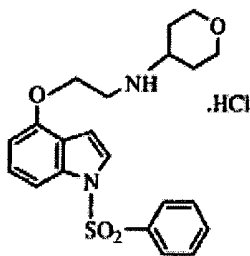
Response to Restriction

Applicants' election with traverse of Group I, claims 1-9 and 15-19 (all claims in part),

drawn to products of Formula (I),



, and specific compound of Example



6, , depicted in page 21, of the specification in response filed on July 08, 2004 is acknowledged. Applicant's arguments filed July 08, 2004 have been fully considered but they are not persuasive with respect to the restriction requirement. Applicants argue that the restriction requirement does not establish that searching all the inventions would constitute an

Art Unit: 1626

undue burden to the Patent Office. Applicant also argues that in the case of an elected product claim, rejoinder is to be permitted when a product claim is found allowable and the withdrawn process claim depends from or otherwise includes all the limitations of an allowed product claim. Applicant traverses the restriction requirement if, once the elected species has been found to be allowable, examination is not expanded to generic claims encompassing the elected species. Applicant also argues that restricting the claims in the manner suggested in the restriction requirement constitutes an undue burden to Applicants as well as the public.

However, even though an art rejection has not been made in this application, the requirement for restriction is maintained and the search has not been extended. It is pointed out that the restriction requirement is made under 35 U.S.C. 121. 35 U.S.C. 121 gives the Commissioner (Director) the authority to limit the examination of an application where two or more independent and distinct inventions are claimed to only one invention. The Examiner has indicated that more than one independent and distinct invention is claimed in this application and has restricted (limited) the claimed subject matter accordingly. For example, the claims encompass heteroaryl groups which are variously classified, therefore "heteroaryl" has been restricted out of the generic embodiment identified for examination. The following is an illustration of the varied classification of the heteroaryl groups: pyrazinyl is classified in class 544 and subclass 336+; pyrimidinyl is classified in class 544 and subclass 242+; pyridinyl is classified in class 546 and subclass 268.1+; oxazolyl is classified in class 548 and subclass 215+; thiazolyl is classified in class 548 and subclass 146+; etc. . . . Thus, the requirement to restrict the claims in this application is predicated on the fact that the claimed subject matter involves more than one independent and distinct invention. No where to Applicants argue to the contrary. No

Art Unit: 1626

where do Applicants point out and give reasons why the claims do not involve independent or distinct subject matter. Accordingly, the restriction is proper. Moreover, it would constitute a burden to extend the search because separate search considerations would be involved in both the U.S. Patents and in the literature. The examination process following the search could easily result in different and thus burdensome considerations.

The restriction requirement here is predicated on the premise that the various compounds involved differ in structure and element so much so as to be patentably distinct, i.e. a reference which anticipated the elected compounds claimed would not even render obvious the others. Again, 35 U.S.C. 121 gives the Commissioner (Director) the authority to limit the examination of an application to a single invention. Applicant has not presented evidence that the examined subject matter is patentably indistinct from the non-examined subject matter. Nor have the even argued to the contrary. Moreover, the sheer number of variables, their huge possibilities, and the almost incomprehensible number of permutations and combinations thereof result in compounds so numerous and diverse so as to be a burden just to classify, search, and examine. Accordingly, the requirement to restrict is considered proper and is maintained. The search and examination of the application is directed to the generic embodiment identified for examination only.

The claims in the elected Group have not been found allowable, therefore, the possibility of rejoinder of Groups II and III cannot be addressed at this time. Whether the public will be inconvenienced because they will not know whether Applicants will file a divisional application to the non-elected subject matter is not a required consideration for a restriction requirement (see 35 U.S.C. 121). In accordance with M.P.E.P. 821.04 and *In re Ochiai*, 71 F.3d 1565, 37 USPQ 1127 (Fed. Cir. 1995), rejoinder of product claims and method of use claims commensurate in

Art Unit: 1626

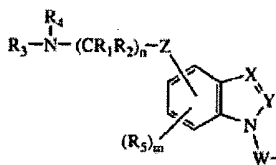
scope with the allowed product claims will occur following a finding that the product claims are allowable. Until such time, a restriction between product claims and process is deemed proper.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Status of the Claims

Claims 1-20 are pending in this application. Claims 1-9 (in part), 9-14, 15-19 (in part) and 20, as previously stated, are withdrawn from further consideration by the Examiner, 37 C.F.R. § 1.142(b), as being drawn to a non-elected invention. The withdrawn subject matter is patentably distinct from the elected subject matter as it differs in structure and element and would require separate search considerations. In addition, a reference, which anticipates one group, would not render obvious the other.

The scope of the invention of the elected subject matter is as follows:



Compounds of formula I,

,depicted in claim 1, wherein:

W is as claimed; Y is CR₇; X is N; R₁ – R₂ are as defined; one of R₃ or R₄ represents a heterocyclic group having one oxygen as a heteroatom and the other is as defined except that it does not represent a heterocyclic group; R₆ – R₉, R₁₃, R₁₄, and R₂₀ – R₂₄ are as defined except wherein they represent a heteroaryl; R₁₀ – R₁₂ and R₁₅ – R₁₉ are as claimed

Art Unit: 1626

As a result of the election and the corresponding scope of the invention identified supra, the remaining subject matter of claims 1-6 are withdrawn from further consideration pursuant to 37 CFR 1.142 (b) as being drawn to non-elected inventions. The withdrawn compounds contain varying functional groups such as , piperdine, thiopiran, pyran, pyrrole etc, which are chemically recognized to differ in structure and function. This recognized chemical diversity of the functional groups can be seen by the various classifications of these functional groups in the U.S. classification system, i.e. class 546 subclass 249(+) (pipedine), class 548 subclass 400(+) (pyrrole), class 549 subclass 1(+) (thiopyran) etc. Therefore the subject matter which are withdrawn from consideration as being non-elected subject differ materially in structure and composition and have been restricted properly a reference which anticipated but the elected subject matter would not even render obvious the withdrawn subject matter and the fields of search are not co-extensive.

Objections

Claims 1-9 and 15-19 are objected to for containing elected and non-elected subject matter. It is suggested that the claims be amended to be limited to the elected invention as identified supra.

Telephone Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kamal A Saeed whose telephone number is (571) 272-0705. The examiner can normally be reached on M-T 7:30 AM- 5:00 PM.

Communication via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signiture, may be used by applicant and should be

Art Unit: 1626

addressed to [joseph.mckane@uspto.gov]. All Internet e-mail communications will be made of record in the application file. PTO employees will not communicate with applicant via Internet e-mail where sensitive data will be exchanged or where there exists a possibility that sensitive data could be identified unless there is of record an express waiver of the confidentiality requirements under 35 U.S.C. 122 by the applicant. See the Interim Internet Usage Policy published by the Patent and Trademark Office Official Gazette on February 25, 1997 at 1195 OG 89.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or public PAIR only. For more information about the pair system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197.

Kamal Saeed
Kamal Saeed, Ph.D.,
Patent Examiner, AU 1626
09/28/04